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9202  
3724  
Attorney Docket No. 688-098

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

-X

In re Application of

Group Art Unit: 3724

Nichols et al.

Serial No. 09/727,364

Examiner: Douglas D. Watts

Filed: November 29, 2000

For: CUTTING DEVICE

-X

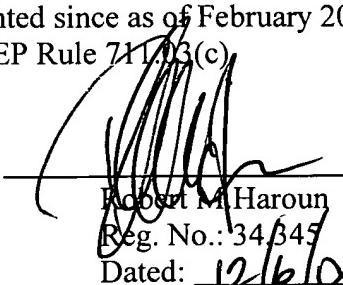
COMMUNICATION

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

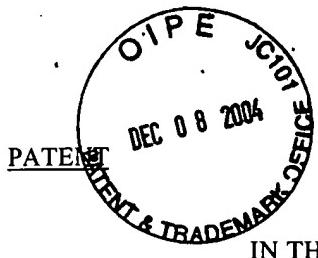
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TECHNOLOGY CENTER R3700

Dear Sirs:

After reviewing our files we realized that we never received a response to the Petition to Withdraw Holding of Abandonment that we filed on August 4, 2003 for the above-identified application. My assistant contacted the Petitions Office and they advised her to speak to Examiner Steven Marcus, whom she spoke to. Examiner Marcus informed my assistant that at the time the Petition was filed a Terminal Disclaimer was required, therefore the petition was dismissed. Examiner Marcus informed my assistant that since we never received the Decision on Petition he will re-fax it to our office on December 6, 2004 and we may re-submit the petition that we filed on August 4, 2003 and the petition will be granted since as of February 2004 Terminal Disclaimers are not required according to the MPEP Rule 711.03(c).

  
Robert M. Haroun  
Reg. No.: 34,345  
Dated: 12/6/04

SOFER & HAROUN L.L.P.  
317 Madison Avenue  
Suite 910  
New York, NY 10017  
Phone (212) 697-2800  
Facsimile (212) 697-3004



Docket No. 688-098

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Nichols et al.  
Serial No. : 09/727,364  
Filed : November 29, 2000  
For : CUTTING DEVICE

CERTIFICATE OF MAILING (37 C.F.R. 1.8a)

Mail Stop Petition  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I hereby certify that the attached Communication, Copy of the Decision of Petition, Copy of Petition to Withdraw Holding of Abandonment filed on August 4, 2003, and Return Postcard along with any paper(s) referred to as being attached or enclosed and this Certificate of Mailing are being deposited with the United States Postal Service on the date shown below with sufficient postage as first-class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Respectfully submitted,

SOFER & HAROUN, L.L.P.

By: Sandria Cirillo  
Sandria Cirillo

Date: 12/6/04

Mailing Address:

SOFER & HAROUN, L.L.P.  
317 Madison Avenue, Suite 910  
New York, New York 10017  
Tel:(212)697-2800  
Fax:(212)697-3004

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TECHNOLOGY CENTER H3700



Patent and Trademark Office  
Technology Center 3700  
Workgroups 3710/3720  
Director's Office CP2-10A12

Mailbox Address: Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
(571) 272-4050

FAX COVER SHEET

DATE: December 6, 2004

TO: Company/Agency/Office: Sofer & Haroun, LLP  
Attention: SANDRA  
FAX Number: (212) 697-3004

FROM: Sender: STEPHEN MARCUS, SPRE, TECHNOLOGY CENTER 3700  
Office Phone Number: (571) 272-4368  
Originating/Return FAX Number: (571) 272-0275

Number of Pages Including Cover Page: 3

Remarks: As per our conversation this morning, please find a copy of a petition decision in 09/727,364. Please note that any material submitted by facsimile transmission for filing in an application must be faxed to the Official fax number (703) 872-9306.

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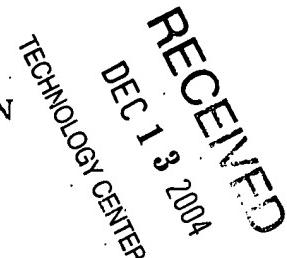
SEP - 3 2003



In re Application of  
Travis Nichols et al  
Application No. 09/727,364  
Filed: November 29, 2000  
Attorney Docket No. 688-098

DECISION ON PETITION

Paper No. 11



This is a decision on the petition filed on August 4, 2003 by which petitioners request withdrawal of the holding that this application stands abandoned for failure to file a proper and timely reply to the Office letter dated December 3, 2001. There is no fee for the petition.

The petition is dismissed as being untimely filed.

The record shows that on December 3, 2001, a requirement to elect a single species of the disclosed invention was mailed. On March 18, 2003, a Notice of Abandonment was mailed because petitioners had failed to file a reply to the election requirement. This petition was filed on August 4, 2003, with a 37 CFR 1.8(a) certificate of mailing dated July 31, 2003.

Under 37 CFR 1.181(f), a petition filed more than two months after the action complained of may be dismissed as being untimely. MPEP § 711.03(c) states, *inter alia*:

"37 CFR 1.181(f) provides that, *inter alia*, except as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR 1.181) to withdraw the holding of abandonment not filed within 2 months of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR 1.181(f).

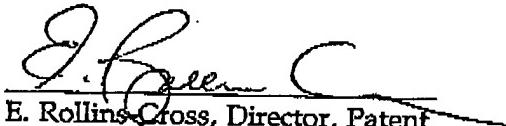
Rather than dismiss an untimely petition to withdraw the holding of abandonment under 37 CFR 1.181(f), the Office may treat an untimely petition to withdraw the holding of abandonment on its merits on the condition that, in any design application, any utility application filed before June 8, 1995, or any plant application filed before June 8, 1995, the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period between the mail date of the notice of abandonment and the filing date of such petition to withdraw the holding of abandonment. See 37 CFR 1.183 (the Office may suspend or waive the requirements of 37 CFR 1.181(f), subject to such other requirements as may be imposed). The Office may treat an untimely petition to withdraw the holding of abandonment on its merits in a utility or plant application filed on or after June 8, 1995, on the condition that the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon that would extend beyond the date 20 years from the filing date of the application, or the earliest application to which the application specifically refers under 35 U.S.C. 120, 121, or 365(c). In either case, the terminal disclaimer must also apply to any patent granted on any application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c). Such a terminal disclaimer is not required under 37 CFR 1.137(d) because abandonment of an application is a per se failure to exercise due diligence, and as such, an applicant cannot obtain patent term extension under 35 U.S.C. 154(b) due to prosecution delay caused by abandonment of the application. Where a petition to withdraw the holding of abandonment is granted, the application is considered to never have been abandoned and, as such, the prosecution delay caused by the treatment of the application as abandoned is not considered a per se failure to exercise due diligence. Thus a terminal disclaimer is required to avoid granting patent term extension under 35 U.S.C. 154(b) due to prosecution delay caused by the treatment of the application as abandoned." (Emphasis supplied.)

Because this petition was filed more than two months after the mailing of the Notice of Abandonment, this petition will not be treated on the merits absent a terminal disclaimer complying with the emphasized portions of the above quoted text. Petitioners may file a renewed petition, without fee, if the renewed petition is accompanied by a proper terminal disclaimer and the fee for the disclaimer.

As a courtesy to petitioners, it is noted that the instant petition was not accompanied by a copy of the reply alleged to have been filed on February 8, 2002. Absent a copy of that reply, the renewed petition can not be decided on its merits.

This application is being retained in Technology Center 3700 pending the filing of a renewed petition.

PETITION DISMISSED.

  
E. Rollins Cross, Director, Patent

Examining Groups 3710 and 3720

Robert M. Haroun  
Sofer & Haroun, LLP  
Suite 1921  
342 Madison Avenue  
New York, NY 10173



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TECHNOLOGY CENTER R3700

Commissioner of Patents & Trademarks  
Washington, D.C. 20231

Sir: Please stamp the date of receipt and the serial number, if appropriate, hereon, and return by mailing. Thank you.

Documents:

- 1) Petition to Withdraw Holding of Abandonment
- 2) two Exhibits
- 3) Certificate of Mailing
- 4) Return Postcard

Date Documents Mailed: July 31, 2003

-----For Application-----

Title: CUTTING DEVICE

Serial No. 09/727,364

Applicant: Nichols et al.

Attorney: Robert M. Haroun

Filing Date: November 29, 2000

608-098



Commissioner of Patents & Trademarks  
Washington, D.C. 20231

Sir: Please stamp the date of receipt and the serial number, if appropriate, hereon, and return by mailing. Thank you.

Documents:

- 1) Petition to Withdraw Holding of Abandonment
- 2) two Exhibits
- 3) Certificate of Mailing
- 4) Return Postcard

Date Documents Mailed: July 31, 2003

-----For Application-----

Title: CUTTING DEVICE

Serial No. 09/727,364

Applicant: Nichols et al. Filing Date: November 29, 2000

Attorney: Robert M. Haroun

PATENT

Docket No. 688-098

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Nichols et al.  
Serial No. : 09/727,364  
Filed : November 29, 2000  
For : CUTTING DEVICE

CERTIFICATE OF MAILING (37 C.F.R. 1.8a)

HON. COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

Sir:

I hereby certify that the attached a copy of the Petition to Withdraw Holding of Abandonment, Two Exhibits, and Return Postcard along with any paper(s) referred to as being attached or enclosed and this Certificate of Mailing are being deposited with the United States Postal Service on the date shown below with sufficient postage as first-class mail in an envelope addressed to the: Commissioner of Patents, Alexandria, VA 22313-1450.

Respectfully submitted,

SOFER & HAROUN, L.L.P.

By: Ester Aronova

Ester Aronova

Date: 7/31/03

Mailing Address:

SOFER & HAROUN, L.L.P.  
317 Madison Avenue, Suite 910  
New York, New York 10017  
Tel:(212) 697-2800  
Fax:(212) 697-3004

Attorney Docket No. 688-098

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

-----X

In re Application of

Nichols et al.

Examiner: Douglas D Watts  
Group Art Unit: 3724

Serial No. 09/727,364

Filed: November 29, 2000

For: CUTTING DEVICE

-----X

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT  
UNDER 37 CFR 1.181**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Dear Sirs:

Applicants hereby file this Petition to Withdraw Holding of Abandonment pursuant to 37 CFR 1.181.

Pursuant to 37 CFR 1.181(b), embodied herein is a concise statement of the pertinent facts and the necessary Exhibits to support this petition. It is asserted by the Applicants that no fee is due under this Petition to Withdraw Holding of Abandonment.

A Notice of Abandonment was mailed on July 21, 2003 stating that the present application went abandoned for failure to respond to the "Office letter" mailed on December 3, 2001. A copy of the Notice of Abandonment is attached hereto as Exhibit 1. However, on

January 16, 2002, Applicants filed a Response to Election Requirements in response to the Office Action dated December 3, 2001. A copy of the return postcard indicating the receipt of the documents by the patent office is attached hereto as Exhibit 2.

This Petition to Withdraw Holding of Abandonment has been prepared immediately and all reasonable steps have been taken to promptly correct the U.S. Patent Office mistake. Applicants respectfully submit that the U.S. Patent Office's abandonment of this Application is in error. As such, Applicants submit this grantable Petition to Withdraw Holding of Abandonment and request that the Office of Petitions withdraw the abandonment of this Application and consider that response to the Office Action that was mailed on January 16, 2003.

Applicants authorize the U.S. Patent Office to charge any additional charges that may arise under this petition to deposit account No. 19-2825 order number 688-098.

Respectfully Submitted,

SOFER & HAROUN

By:

  
\_\_\_\_\_  
Robert M. Haroun, Esq.  
Reg No. 34,345  
317 Madison Avenue  
Suite 910  
New York, NY 10017  
(212) 697-2800

Dated: 1/31/03

# **EXHIBIT 1**

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
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[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,364	11/29/2000	Travis Nichols	688-098	3368

7590 03/18/2003

Robert M. Haroun  
SOFER & HAROUN, LLP  
Suite 1921  
342 Madison Avenue  
New York, NY 10173

[REDACTED] EXAMINER

[REDACTED] WATTS, DOUGLAS D

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3724

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Notice of Abandonment</b>	<b>Application No.</b> 09/727,364 <b>Examiner</b> Douglas D. Watts	<b>Applicant(s)</b> NICHOLS ET AL. Art Unit 3724
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1.  Applicant's failure to timely file a proper reply to the Office letter mailed on 03 December 2001.
  - (a)  A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b)  A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c)  A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d)  No reply has been received.
2.  Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a)  The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b)  The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c)  The issue fee and publication fee, if applicable, has not been received.
3.  Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a)  Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b)  No corrected drawings have been received.
4.  The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5.  The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6.  The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7.  The reason(s) below:

DOUGLAS D. WATTS  
PRIMARY EXAMINER

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



UNITED STATES PATENT AND TRADEMARK OFFICE

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[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,364	11/29/2000	Travis Nichols	688-098	3368

7590 03/18/2003

Robert M. Haroun  
SOFER & HAROUN, LLP  
Suite 1921  
342 Madison Avenue.  
New York, NY 10173

[REDACTED] EXAMINER

WATTS, DOUGLAS D

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3724

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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# **EXHIBIT 2**

Mr: Please stamp the date of receipt and the serial number, if appropriate, hereon, and return by mailing. Thank you.

Documents:

- 1) Response to Election Requirements
- 2) Replacement Pages
- 3) Certificate of Mailing
- 4) Return Postcard

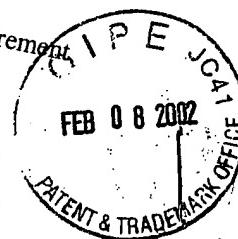
Date Documents Mailed: January 16, 2002  
For Application

Title: CUTTING DEVICE  
Serial No. 09/727,364

Applicant: Nichols et al.

Attorney: Robert M. Haroun

Filing Date: November 29, 2000



Off-098